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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/031,263

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Robert W. Monster

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PERKINS COIE LLP

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EXAMINER

JACKSON, JAKIEDA R

ART UNIT

PAPER NUMBER

2626

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/031,263	Applicant(s) MONSTER, ROBERT W.	
	Examiner Jakieda R. Jackson	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 8/21/06.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-11 and 13-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-11 and 13-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Amendment*

1. In response to the Office Action mailed August 21, 2006, applicant submitted an amendment filed on February 16, 2007, in which the applicant amended and requested reconsideration with respect to **claim 1**.

### *Response to Arguments*

2. Applicant argues that the claims as amended overcome the Berstis reference. Applicant's arguments are persuasive but are moot in view of new grounds of rejection.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 2-11 and 13-22** are rejected under 35 U.S.C. 102(b) as being anticipated by Chong et al. (USPN 5,535,120), hereinafter referenced as Chong.

Regarding **claims 2 and 13**, Chong discloses a method and apparatus comprising:

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determining, as part of an electronic mail generation system, a preferred language of an electronic mail recipient (e-mail capability; column 8, lines 29-48 with column 13, lines 49-66 and column 19, lines 14-65);

writing header information to an electronic mail message based on the preferred language (format; column 6, lines 56 – column 7, line 3 with column 13, lines 49-6);

writing a body to the electronic mail message (format; column 6, lines 56 – column 7, line 3); and

sending the electronic mail message to the electronic mail recipient (transmit the translated text to recipient; column 6, lines 56 – column 7, line 3 and column 19, lines 14-65).

Regarding **claims 3 and 14**, Chong discloses a method and apparatus wherein the preferred language is determined by querying a database of the system (searching; column 13, lines 49-66).

Regarding **claims 4 and 15**, Chong discloses a method and apparatus where the header information comprises character coding information based on the preferred language (character code; column 20, lines 35-49).

Regarding **claims 5 and 16**, Chong discloses a method and apparatus wherein the character coding information comprises one or more of MIME-Version header field, a content type header field, a content transfer encoding field and a character set parameter of the content type header field (header; column 7, lines 32-62 and column 20, lines 35-49).

Regarding **claims 6 and 17**, Chong teaches all of the limitations as claimed in claims 2 and 13. In addition, Chong discloses a method and apparatus wherein the electronic mail generation system is part of a research system (market reports; column 10, lines 60-67).

Regarding **claims 7 and 18**, Chong discloses a method and apparatus wherein the electronic mail message is generated automatically in response to an event of the survey system (market reports; column 10, lines 60-67).

Regarding **claims 8 and 19**, Chong discloses a method and apparatus wherein the recipient is expressed in a manner dependent on the preferred language (column 19, lines 14-65).

Regarding **claims 9 and 20**, Chong discloses a method and apparatus further comprising sending the electronic mail message to the recipient expressed in the language manner (transmit formatted text; column 19, lines 14-65).

Regarding **claims 10 and 21**, Chong discloses a method and apparatus further comprising determining a culturally appropriate salutation for the recipient based on the preferred language (sex indicative titles; column 11, lines 7-20 with column 13, lines 35-48).

Regarding **claims 11 and 22**, Chong discloses a method and apparatus further comprising:

constructing the culturally appropriate salutation based on the recipient's name and the preferred language (sex indicative titles; column 11, lines 7-20 with column 13, lines 35-48); and

writing to a body of the electronic mail message the culturally appropriate salutation (sex indicative titles; column 11, lines 7-20 with column 13, lines 35-48).

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 2-5 and 13-16** are *alternately* rejected under 35 U.S.C. 102(e) as being anticipated by Homan et al. (USPN 6,233,317), hereinafter referenced as Homan.

Regarding **claims 2 and 13**, Chong discloses a method and apparatus comprising:

determining, as part of an electronic mail generation system, a preferred language of an electronic mail recipient (indication in which subscriber prefers to receive; column 5, line 2 – column 6, line 24);

writing header information to an electronic mail message based on the preferred language (composing electronic mail message; column 5, line 2 – column 6, line 24);

writing a body to the electronic mail message (composing electronic mail message; column 5, line 2 – column 6, line 24); and

sending the electronic mail message to the electronic mail recipient (email\_send; column 5, line 2 – column 6, line 24).

Regarding **claims 3 and 14**, Chong discloses a method and apparatus wherein the preferred language is determined by querying a database of the system (prefers; column 5, line 2 – column 6, line 24).

Regarding **claims 4 and 15**, Chong discloses a method and apparatus where the header information comprises character coding information based on the preferred language (character code; column 5, line 2 – column 6, line 24).

Regarding **claims 5 and 16**, Chong discloses a method and apparatus wherein the character coding information comprises one or more of MIME-Version header field, a content type header field, a content transfer encoding field and a character set parameter of the content type header field (column 5, line 2 – column 6, line 24 with column 7, lines 51-67).

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Evans (PGPUB 203/0200505) discloses a method and apparatus for overlaying a source text on an output text.
- Flanagan et al. (USPN 5,966,685) disclose a system for parallel foreign language communication over a computer network.
- Scanlan (PGPUB 2005/0246156) discloses a communication processing system.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jakieda R. Jackson whose telephone number is 571-272-7619. The examiner can normally be reached on Monday, Tuesday and Thursday 7:30 a.m. to 5:00p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on 571-272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JRJ  
April 26, 2007



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